

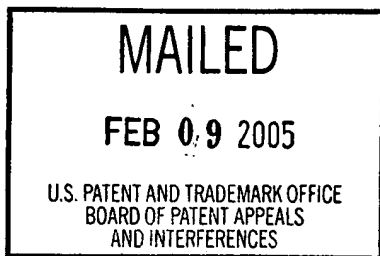
The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte IGOR SINYAK and DAVID L. SPRAGUE



Appeal No. 2004-1329
Application No. 09/371,716

ON BRIEF

Before HAIRSTON, KRASS, and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-31, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

Appellants' invention relates to a system for data display using multicolumn scrolling. Appellants' invention scrolls the text within a multicolumn document where the text moves through the columns by spilling from the top of one column to the bottom of the previous column and vice versa rather than merely having the cursor scrolling from column to column. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method comprising displaying line-formatted materials on a screen display in two or more adjacent columns, wherein lines spill from the bottom of one column to the top of an adjacent column, or from the top of one column to the bottom of an adjacent column, when scrolling through the line-formatted materials.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Edgar	6,113,394	Sep. 05, 2000 (Effective filing date Sep. 04, 1996)
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Truong	6,151,609	Nov. 21, 2000 (Filed Aug. 16, 1996)
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WordPerfect 6.1 for Windows, Corel Corporation, Release date Apr. 15, 1996, screen shots, pps 1-18.

Claims 1-3, 5, 9, 13-15, 17, 25, 26, 29, and 31 stand rejected under 35 U.S.C.

§ 103 as being unpatentable over WordPerfect 6.1 for Windows. Claims 4 and 16

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stand rejected under 35 U.S.C. § 103 as being unpatentable over WordPerfect 6.1 for Windows in view of Edgar. Claims 6-8, 10-12, 18-24, 27, 28, and 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Truong in view of WordPerfect 6.1 for Windows.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 17, mailed Dec. 17, 2003) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 16, filed Nov. 3, 2003) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

35 U.S.C. § 103

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. See *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be

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sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. **See In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination `only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.'" **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 999-1000, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the language of independent claim 1. It is the language of the claim as interpreted in light of appellants' disclosure that dictates the metes and bounds of the claimed invention.

From our review of the prior art as applied by the examiner, we find that the examiner has not appropriately interpreted the invention as recited in the claims nor has the examiner interpreted the claimed invention with respect to those express definitions as set forth in appellants' specification. Therefore, we find error with the examiner's claim interpretation and with the application of the prior art thereagainst.

Appellants argue that the examiner has not established a *prima facie* case of obviousness of the claimed invention. (See brief at page 6.) We agree with appellants. Appellants argue that the specification sets forth specific definitions of the claim terms "line-formatted materials" and "spilling lines" at pages 4-5 of the specification. (See brief at pages 7-8.) We agree with appellants and find that the examiner has not properly interpreted the claim terminology. From our review of the screen shots from WordPerfect 6.1 for Windows, we find a scrolling of the cursor through the text in columns from the top to the bottom of the text, but we find no "spilling" of the text during scrolling. The portion of the text insertion at pages 17 and 18 of WordPerfect 6.1 for Windows does perform some spilling of text during the insertion of data into the form, but this is not "wherein lines spill from the bottom of one column to the top of an adjacent column, or from the top of one column to the bottom of

an adjacent column, when scrolling through the line-formatted materials” as recited in the claims. Nor do we find that the insertion of data would have suggested the spill of data during the scrolling through the line-formatted materials. Therefore, we agree with appellants that the examiner has not established a ***prima facie*** case of obviousness of independent claim 1. Therefore, we cannot sustain the rejection of independent claim 1 and its dependent claims. With respect to independent claim 13, we find a similar lack of a ***prima facie*** case of obviousness, and we cannot sustain the rejection of this claim and its dependent claims. Nor do we find that the teachings of Edgar remedy the above deficiency for dependent claims 4 and 16.

With respect to independent claims 6, 11, 12, 18, and 23-25, the examiner relies upon the teachings of Truong to evidence the well-known use of web browsers, but relies upon the teachings of WordPerfect as discussed above with respect to line-formatted materials and spilling of lines during scrolling. As noted above, we do not find that WordPerfect teaches or fairly suggests the recited claim limitations, and thus, we cannot sustain the rejection of independent claims 6, 11, 12, 18, and 23-25 and their dependent claims.

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CONCLUSION

To summarize, the decision of the examiner to reject claims 1-31 under 35 U.S.C. § 103 is reversed.

REVERSED


KENNETH W. HAIRSTON
Administrative Patent Judge


ERROL A. KRASS
Administrative Patent Judge

) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES


JOSEPH L. DIXON
Administrative Patent Judge

JLD/vsh

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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402